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NEW YORK, NY 10038

EXAMINER
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CHAMPAGNE, LUNA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SCOTT T. ALLAN, JEFFERY T. MILES, J. GREG STOUT,  
AZIZ VALLIANI, ABBAS RAFII, and NAZIM KAREEMI

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Appeal 2008-4903  
Application 09/480,883  
Technology Center 3600

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Decided:<sup>1</sup> February 3, 2009

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Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.  
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

The Appellants seek our review under 35 U.S.C. § 134 of the Final Rejection of claims 38-41 and 45-58 which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM.

## THE INVENTION

The Appellants' claimed invention is directed to a web-based transaction data storage and retrieval system for merchants and customers. Transaction data including signatures are securely transmitted from the merchant to the remote, transaction-record repository. When a transaction record (a receipt, for example) is required, the customer, the merchant's employees, or designated financial agents of the customer or the merchant access the electronics-records service through the Internet using a web browser. (Specification 7:10:25). Claim 38, reproduced below, is representative of the subject matter of appeal.

38. A method, comprising the steps of:
  - receiving a transaction record including an electronically captured signature from a point-of-sale terminal, the transaction record corresponding to a consumer;
  - storing the transaction record in a transaction database, the transaction database including a plurality of transaction records; and
  - providing access by a user computer to the transaction record in the transaction database, wherein the transaction record is accessible to a plurality of users and the transaction database

restricts access by a user to the transaction records corresponding to a role defined for the user, at least two of the users having different roles, and wherein the access includes initiating an action using the user computer, the action including one of correcting a transaction, canceling a portion of the transaction, repeating a portion of the transaction as part of a new transaction, and modifying a portion of the transaction.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Tognazzini	US 5,739,512	Apr. 14, 1998
Robinson	US 5,915,022	Jun. 22, 1999
Francini	EPO 474 360 A2	Mar. 11, 1992

The following rejections are before us for review:

1. Claims 38-41, 45-50, 52, 56-58 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson.
2. Claims 51 and 53-55 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tognazzini and Robinson.

### THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns first on whether Robinson discloses that a user may cancel a portion of the transaction record.

This issue turns second on whether Robinson shows that the transaction record is accessible to a plurality of users having different roles.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>2</sup>

FF1. Robinson discloses that the “merchant computer 98 may opt to request that the customer confirm the placement of the order, as shown in step 104” (Col. 3:62-65).

FF2. Robinson further discloses that the customer may at that point choose options such as “Place Order” or “Cancel Order” (Col. 3:65-Col. 4:3).

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

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secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

## ANALYSIS

### *Claims 38-41, 45-50, 52, and 56-58*

The Appellants argue as a group the rejection of claims 38-41, 45-50, 52, and 56-58 under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson. We select claim 38 as representative of this group and the remaining claims stand or fall with claim 38. See 37 C.F. R. § 41.37 (c)(1)(vii) (2007).

The Appellants argue that the rejection of claim 38 is improper because Robinson fails to disclose the limitation:

wherein the access includes initiating an action using the user computer, the action including one of correcting a transaction, canceling a portion of the transaction, repeating a portion of the transaction as part of a new transaction, and modifying a portion of the transaction . . . .

(Claim 38).

The Appellants argue Robinson is unrelated to accessing a transaction record because Robinson creates a transaction record in a step following the confirmation of the order (Br. 5-6). The Appellants argue that placing an order is an offer to enter into a transaction, and that canceling an order is a withdrawal of the offer to enter into a transaction (Br. 6).

The Appellants further argue that the rejection of claim 38 is improper because Robinson fails to disclose the limitation:

wherein the transaction record is accessible to a plurality of users and the transaction database restricts access by a user to the transaction records corresponding to a role defined for the user, at least two of the users having different roles . . . .

(Claim 38).

The Appellants argue that the Examiner has erred in equating the term “customer” of Robinson with the “plurality of users” recited in claim 38 since Robinson encrypts an altered version of the transaction record and thus prevents access for the customers into the transaction record (Br. 7).

In contrast the Examiner has determined that Robinson discloses the claimed limitation by showing that a dispute may be resolved by a merchant which may involve modifying a transaction (Ans. 10). The Examiner has also determined that Robinson discloses two users having different roles by disclosing customers correcting a transaction by canceling an order (Ans. 6).

### *Claim Construction*

We first construe the meaning of the term “transaction record” as used by the appellant in the claims. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written

description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). The Specification states

When a *transaction record* (a receipt, for example) is required, the customer, the merchant's employees or designated financial agents of the customer or the merchant (banks or payment processors, for example) access the electronics-records service through an internet using a web browser . . . .

(Specification 7:18-22, emphasis added).

Here, there is no requirement that the “transaction record” *must* be a receipt since it is given as an *example* or particular embodiment. Therefore giving the term “transaction record” its broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art we do not construe it to be limited to a receipt or “completed transaction” as the Specification does not describe it as such.

### *Analysis*

As noted in the claim construction section above, claim 38 does not require that the “transaction record” be a receipt for a completed purchase. Regardless, Robinson discloses that the merchant computer 98 *may* opt to request that the customer confirm the placement of the order (FF1) and there is no requirement that the request for confirmation take place. As the merchant *may* request that the order be confirmed this shows that an *order* or some *transaction record*, completed or uncompleted, has already taken place. Robinson further discloses that the customer may at that point choose options



such as “Place Order” or “Cancel Order” (FF2), further showing that the *order* or some *transaction record* has already taken place and that the customer may alter it. Since the customer may *cancel the order* in Robinson, this meets the claimed limitation for “initiating an action using the user computer, the action including one of correcting a transaction, *canceled a portion of the transaction*, repeating a portion of the transaction as part of a new transaction, and modifying a portion of the transaction” as claimed. Further, since the customer may *access* this transaction record it meets the claimed limitation for “wherein the transaction record is *accessible* to a *plurality of users* and the transaction database restricts access by a user to the transaction records corresponding to a role defined for the user, at least two of the users having different roles” (emphasis added) since both the merchant and customer can view the order. Since the customer may cancel the order (FF2) the transaction record may be altered. For these reasons, the rejection of claims 38-41, 45-50, 52, and 56-58 under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson is sustained.

#### *Claims 51 and 53-55*

The Appellants argue that the rejection of claims 51 and 53-55 under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson is improper for the same reasons as addressed above. Accordingly, the rejection of these claims 51 and 53-55 is sustained for the reasons given *supra*.

### CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 38-41, 45-50, 52, and 56-58 under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson.

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 51 and 53-55 under 35 U.S.C. § 103(a) as unpatentable over Tognazzini, Francini, and Robinson.

### DECISION

The Examiner's rejection of claims 38-41 and 45-58 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

### AFFIRMED

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